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10/652,109

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Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID L. KAMINSKY, CHRISTOPHER J. ROGUS,
and KYLE M. SMITH

Appeal 2009-003736
Application 10/652,109
Technology Center 2100

Decided: April 19, 2010

Before JOHN A. JEFFERY, JAY P. LUCAS, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) (2002) from the Examiner's rejection of claims 1-13. We have jurisdiction under 35 U.S.C. § 6(b) (2008).

We affirm in part.

STATEMENT OF THE CASE

INVENTION

The invention on appeal is directed generally to the field of computer-human interactions. More particularly, the invention on appeal is directed to the configuration of a user interface to facilitate computer-human interactions through the user interface. (Spec. 1).

ILLUSTRATIVE CLAIM

1. A system for autonomically configuring a user interface comprising:

at least one widget programmed to be disposed in the user interface, said at least one widget comprising a dynamically configurable presentation field; and,

a policy comprising a plurality of business rules for configuring said at least one widget in the user interface based upon a context provided by said at least one widget; and,

a rules engine configured to process said business rules.

PRIOR ART

The Examiner relies upon the following reference as evidence:

Underwood

US 6,601,233 B1

Jul. 29, 2003

THE REJECTIONS¹

1. The Examiner rejected claims 1-5 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.
2. The Examiner rejected claims 1-13 under 35 U.S.C. § 102(e) as anticipated by Underwood.

GROUPING OF CLAIMS

Regarding the Examiner's rejection under § 102, we accept Appellants' grouping (App. Br. 8). Therefore, claims 2, 5-10, and 13 stand or fall with independent claim 1, claim 11 stands or falls with claim 3, and claim 12 stands or falls with claim 4. Thus, we decide the appeal of the § 102 rejection on the basis of representative claims 1, 3, and 4. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUES

Appellants contend that claims 1-5 are directed to statutory subject matter under § 101 because their system for autonomically configuring a user interface: (1) produces a useful, concrete, and tangible result² (App. Br.

¹ We note that the Examiner has neglected to include page numbers in the Answer. Nevertheless, we make reference to the Answer by page numbers, counting consecutively from page 1. Additionally, we observe that the Examiner incorrectly refers to the "Reply Brief dated 8/30/2007" throughout the Answer (*e.g.*, *see* Ans. pp. 17 and 19-23). We consider this as a harmless typographical error, as the Examiner clearly intended to refer to the principal Brief, filed August 30, 2007.

² *Citing State Street Bank and Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373 (Fed. Cir. 1998) ("we hold that the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical

8), and (2) claims 1-5 could include hardware, under a broad but reasonable interpretation, citing *In re Comiskey* 499 F.3d 1365, 1379 (Fed. Cir. 2007) (holding that claims 17 and 46 were directed to patentable subject matter, because “under the broadest reasonable interpretation, [these claims] could require the use of a computer as part of Comiskey's arbitration system). (Reply Br. 2-3).

Regarding the Examiner’s rejection under § 102, Appellants argue specific limitations (App. Br. 9-17) that we address *infra*.

Based upon our review of the administrative record, we have determined that the following issues are dispositive in this appeal:

Issue 1: Did the Examiner err in concluding that claims 1-5 are directed to non-statutory subject matter under 35 U.S.C. § 101?

Issue 2: Did the Examiner err in finding that Underwood discloses or describes “configuring said at least one widget in the user interface?” (Independent claim 1).

Issue 3: Did the Examiner err in finding that Underwood discloses or describes “wherein said business rules specify at least one suggested option to be presented to an end user through said at least one widget?” (Dependent claim 3).

application of a mathematical algorithm, formula, or calculation, because it produces ‘a useful, concrete and tangible result.’”).

Issue 4: Did the Examiner err in finding that Underwood discloses or describes “wherein said business rules specify at least one option which is not to be presented to an end user through said at least one widget?” (Dependent claim 4).

PRINCIPLES OF LAW

35 U.S.C. § 101

“The four categories [of § 101] together describe the exclusive reach of patentable subject matter. If a claim covers material not found in any of the four statutory categories, that claim falls outside the plainly expressed scope of § 101 even if the subject matter is otherwise new and useful.” *In re Nuijten*, 500 F.3d 1346, 1354 (Fed. Cir. 2007). *See also* U.S. Patent & Trademark Office, *Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101*, Aug. 2009, at 2, available at http://www.uspto.gov/web/offices/pac/dapp/opla/2009-08-25_interim_101_instructions.pdf (“A claim that covers both statutory and non-statutory embodiments (under the broadest reasonable interpretation of the claim when read in light of the specification and in view of one skilled in the art) embraces subject matter that is not eligible for patent protection and therefore is directed to non-statutory subject matter.”).

Anticipation under § 102

In rejecting claims under 35 U.S.C. § 102, “[a] single prior art reference that discloses, either expressly or inherently, each limitation of a

claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992)).

Anticipation of a patent claim requires a finding that the claim at issue ‘reads on’ a prior art reference. In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.

Atlas Powder Co. v. IRECO, Inc., 190 F.3d 1342, 1346 (Fed. Cir. 1999) (citations omitted).

FINDINGS OF FACT

In our analysis *infra*, we rely on the following findings of fact (FF):

Appellants’ Specification

1. Appellants’ system is disclosed as being “realized in hardware, software, or a combination of hardware and software.” (Spec. 11, ¶ 2).

The Underwood Reference

2. Underwood discloses “[t]he User Interface framework provides components for generating HTML. An HTML page is generated from a combination of the various UI [User Interface] Components.” (Col. 63, ll. 2-5).

3. Underwood discloses various user interface widgets, such as text entry widgets, a radio button widget, and a check box widget. (Col. 63, ll. 30-43).
4. Underwood discloses that UI widgets are mapped to attributes of business objects. (Col. 280, ll. 10-13).
5. Underwood discloses that business logic is packaged as components. (Col. 125, ll. 23-24).
6. Underwood discloses that business components may include, *e.g.*, orders, credit checks and fraud analysis. (Col. 2, ll. 22-24).
7. Underwood discloses:

Business Logic is the core of any application, providing the expression of business rules and procedures (*e.g.*, the steps and rules that govern how a sales order is fulfilled). As such, the Business Logic includes the control structure that specifies the flow for processing business events and user requests.

(Col. 125, ll. 25-30).

8. Underwood discloses:

Bigger Business Components hide more complexity, which in general is a good thing. However, too much complexity in a component can lead to many of the problems that preceded component-based development. For example, embedding too much policy information can lead to a Business Component that is more difficult to maintain and customize.

(Col. 321, ll. 32-38).

ANALYSIS

Issue 1

We decide the question of whether the Examiner erred in concluding that claims 1-5 are directed to non-statutory subject matter under 35 U.S.C. § 101.

Appellants ground their argument presented in the principal Brief on *State Street*. In these times of changing law, an individual patent appeal is judged in the light of the law as it exists at the time of review. We note that our reviewing court in *Bilski* determined that the “useful, concrete, and tangible result” test associated with *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d at 1373 was inadequate. *See In re Bilski*, 545 F.3d 943, 959-960 (Fed. Cir. 2008)(en banc)(cert. granted) (“Therefore, we also conclude that the ‘useful, concrete and tangible result’” inquiry is inadequate and reaffirm that the machine-or-transformation test outlined by the Supreme Court is the proper test to apply.”).

In the Reply Brief, Appellants further contend that claims 1-5 are directed to patentable subject matter because the claimed system could include hardware, under a broad but reasonable interpretation, citing *In re Comiskey* 499 F.3d 1365, 1379 (Fed. Cir. 2007) (holding at 1379-80 that

claims 17 and 46 were directed to patentable subject matter, because under the broadest reasonable interpretation, [these claims] could require the use of a computer as part of Comiskey's arbitration system). (Reply Br. 2-3, underline added).

However, we conclude that the recited “system for autonomically configuring a user interface” is merely a statement of intended purpose regarding how the software elements found in the body of claim are intended to be used. (Claim 1). Moreover, as pointed out by the Examiner (Ans. p. 11 of the “Response to Arguments” section), Appellants’ system is clearly described in the Specification as being “realized in hardware, software, or a combination of hardware and software.” (FF 1, underline added).

Thus, we conclude that Appellants’ claim 1 may be broadly but reasonably construed to encompass both statutory (*e.g.*, hardware) and non-statutory subject matter (*e.g.*, disembodied software). Our reviewing court has determined that “[t]he four categories [of § 101] together describe the exclusive reach of patentable subject matter. If a claim covers material not found in any of the four statutory categories, that claim falls outside the plainly expressed scope of § 101 even if the subject matter is otherwise new and useful.” *In re Nuijten*, 500 F.3d at 1354. *See also* U.S. Patent & Trademark Office, *Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101*, Aug. 2009, at 2, available at http://www.uspto.gov/web/offices/pac/dapp/opla/2009-08-25_interim_101_instructions.pdf (“A claim that covers both statutory and non-statutory embodiments (under the broadest reasonable interpretation of the claim when read in light of the specification and in view of one skilled in

the art) embraces subject matter that is not eligible for patent protection and therefore is directed to non-statutory subject matter.”).

This reasoning is applicable here. Therefore, we agree with the Examiner’s legal conclusion that independent claim 1 is directed to non-statutory subject matter. Because dependent claims 2-5 do not remedy the deficiencies of claim 1 (by limiting the “system” of claim 1 to a statutory subject class), we sustain the Examiner’s rejection of claims 1-5 under 35 U.S.C. § 101.

Issue 2

We decide the question of whether the Examiner erred in finding that Underwood discloses or describes “configuring said at least one widget in the user interface.” (Claim 1).

Appellants contend:

Upon reviewing the passages cited by the Examiner, Appellants note that the Examiner's citations to column 125 and column 316 are completely silent with regard to "configuring said at least one widget in the user interface," as claimed. Moreover, the Examiner's citation to column 32 is completely silent as to the application logic/business rules described in column 125 and the control logic described in column 316. Therefore, it appears that the Examiner is manufacturing a single specific teaching in Underwood so as to identically disclose the claimed limitation by combining multiple completely unrelated teachings from Underwood. However, Appellants respectfully submit that one having ordinary skill in the art would not have recognized Underwood as teaching the claimed "policy comprising a plurality of business rules for configuring said at least one widget in the user interface based upon a context provided by said at least one widget" since the relied upon teachings within Underwood are unrelated. Thus, Underwood

fails to identically disclose the claimed invention, as recited in claim 1, within the meaning of 35 U.S.C. § 102.

(App. Br. 10).

The Examiner disagrees. In particular, the Examiner concludes that “[t]he scope of the recited ‘... configuring said at least one widget in the user interface...’ encompasses an extremely broad range of configuring.” (Ans. 24). Based upon our review of the record, we agree with the Examiner’s claim interpretation. We begin our analysis by noting that the Examiner reads the claimed “at least one widget in the user interface” on Underwood’s user interface widgets. (Ans. 4).

At the outset, we note that Underwood is directed to a business component framework. (*See Title*). Underwood discloses that a user interface framework provides components for generating an HTML page. (FF 2). Underwood expressly discloses various user interface widgets, such as text entry widgets, a radio button widget, and a check box widget. (FF 3; *see also* Ans. 5). Underwood also discloses that user interface widgets are mapped to attributes of business objects. (FF 4). Underwood additionally discloses that business logic is packaged as components (FF 5) and the business components may include, *e.g.*, orders, credit checks and fraud analysis (FF 6), which we find reflect policies (*i.e.*, order, credit check and fraud analysis policies) that each inherently comprise a plurality of business rules. (FF 6-8).

We also note that Underwood expressly discloses that business logic (packaged as components, FF 5) provides the expression of business rules, as follows:

Business Logic is the core of any application, providing the expression of business rules and procedures (e.g., the steps and rules that govern how a sales order is fulfilled). As such, the Business Logic includes the control structure that specifies the flow for processing business events and user requests.

(FF 7).

As pointed out by the Examiner (Ans. 9), Underwood also discloses that business components are associated with policy information:

Bigger Business Components hide more complexity, which in general is a good thing. However, too much complexity in a component can lead to many of the problems that preceded component-based development. For example, embedding too much policy information can lead to a Business Component that is more difficult to maintain and customize.

(FF 8, underline added).

Thus, from the above descriptions in Underwood, we agree with the Examiner that Underwood discloses or describes “configuring said at least one widget in the user interface” in accordance with a policy comprising a plurality of business rules. (Claim 1). Therefore, we affirm the Examiner’s anticipation rejection of representative claim 1. Claims 2, 5-10, and 13 fall with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Issue 3

We decide the question of whether the Examiner erred in finding that Underwood discloses or describes “wherein said business rules specify at least one suggested option to be presented to an end user through said at least one widget.” (Dependent claim 3).

In the principal Brief, Appellants merely restate what claim 3 recites, followed by a statement that it is “unclear” how the passage relied on by the Examiner (Underwood, col. 282, ll. 35-36) is related to business rules where at least one suggested option is specified by the business rules, and teach that the option is presented through the widget. (App. Br. 16).

We note that “[a] statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.” *See* 37 CFR § 41.37(c)(1)(vii). We also note that Appellants have not affirmatively stated in the record that the limitations of claim 3 are not disclosed or described by Underwood. Thus, we find Appellants’ have failed to traverse the merits of the Examiner’s rejection by merely stating that the correspondence is “unclear” between the claim and the portion of Underwood relied on by the Examiner. We note that mere attorney arguments and conclusory statements that are unsupported by factual evidence are entitled to little probative value. *In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997); *see also In re De Blauwe*, 736 F.2d 699, 705 (Fed. Cir. 1984); 37 C.F.R. § 1.111(b); and *Ex parte Belinne*, No. 2009-004693, slip op. at 7-8 (BPAI Aug. 10, 2009) (informative), *available at* <http://www.uspto.gov/web/offices/dcom/bpai/its/fd09004693.pdf>

Moreover, we conclude that the claimed “business rules [that] specify at least one suggested option to be presented to an end user through said at least one widget” (claim 3) broadly but reasonably read on Underwood’s disclosure of various user interface widgets, such as text entry widgets, a radio button widget, and a check box widget that are mapped to attributes of business objects (FF 3-4), consistent with our discussion of claim 1 *supra*.

For at least these reasons, we affirm the Examiner's anticipation rejection of representative claim 3 and claim 11 that falls therewith. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Issue 4

We decide the question of whether the Examiner erred in finding that Underwood discloses or describes "wherein said business rules specify at least one option which is not to be presented to an end user through said at least one widget." (Dependent claim 4).

Based upon our review of the portions of Underwood relied on by the Examiner (col. 12, ll. 42-44, col. 57, ll. 10-13, and col. 302, ll. 40-43),³ we agree with Appellants that the recited negative limitation is not expressly nor inherently disclosed by the cited portions of Underwood. (*See* App. Br. 16-17). For us to affirm the Examiner regarding the negative limitation would require speculation on our part. We decline to engage in speculation. Accordingly, we reverse the Examiner's anticipation rejection of dependent claim 4 and dependent claim 12 which recites commensurate limitations.

CONCLUSIONS

Based on the findings of fact and analysis above:

Issue 1: The Examiner did not err in concluding that claims 1-5 are directed to non-statutory subject matter under 35 U.S.C. § 101.

³ *See* Final Rejection mailed May 31, 2007, pp. 6-7.

Issue 2: The Examiner did not err in finding that Underwood discloses or describes “configuring said at least one widget in the user interface.” (Representative independent claim 1).

Issue 3: The Examiner did not err in finding that Underwood discloses or describes “wherein said business rules specify at least one suggested option to be presented to an end user through said at least one widget.” (Dependent claim 3).

Issue 4: The Examiner erred in finding that Underwood discloses or describes “wherein said business rules specify at least one option which is not to be presented to an end user through said at least one widget.” (Dependent claim 4).

ORDER

We affirm the Examiner’s rejection of claims 1-5 under 35 U.S.C. § 101.

We affirm the Examiner’s rejection of claims 1-3, 5-11, and 13 under 35 U.S.C. § 102(e).

We reverse the Examiner’s rejection of claims 4 and 12 under 35 U.S.C. § 102(e).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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